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EXAMINER

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| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,025

Applicant(s)

LINGLE ET AL.

Examiner

Richard Woo

Art Unit

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WU

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-79 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-6, 8-9, 11, 13.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1) The information disclosure statement filed August 8, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2) Claims 4 and 56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Applicants' invention for printing a currency (e.g. U.S. currency or other foreign currencies) is directly against the U.S. Government policy and, therefore, is directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

3) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4) Claims 29-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 29, line 8, the recitation of "the VBI" lacks antecedent basis.

Claim Rejections - 35 USC § 102

5) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6) Claims 1-2, 5, 7-19, 23-25, 27-31, 33-44, 48-50, 52-54, 57-68, 72-74 and 76-77 are rejected under 35 U.S.C. 102(e) as being anticipated by Kara (US 5,825,893).

W.R.T. Claim 1:

Kara discloses a system comprising:

a client subsystem for interfacing with a user comprising:

a GUI for installing software for printing the value bearing item (see Figs. 2-8 and the description thereof);

a GUI for registering the user in the system (see Id.); and

a GUI for managing the printing of the VBI (see Fig. 8); and

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a server subsystem for transmitting an authorization message to the client subsystem for authorizing the client subsystem to print the VBI while the server subsystem is in communication with the client subsystem (see Figs. 1 and 10; col. 4, lines 1-15; see Claim 1).

W.R.T. Claim 2: Kara further discloses the system, wherein the VBI bears postage value;

W.R.T. Claim 5: Kara further discloses the system, wherein the client subsystem includes a GUI for specifying a payment method (see Figs. 4A-B, 8);

W.R.T. Claim 7: Kara further discloses the system, wherein the client subsystem includes a GUI for displaying the user information, account information (see Figs. 4A-B, 8);

W.R.T. Claim 8: Kara further discloses the system, wherein the account information includes an amount of credit left in the account (see Id.);

W.R.T. Claim 9: Kara further discloses the system, wherein the client subsystem includes a GUI for specifying an address book from a plurality of address books to print the address (see Fig. 8 and the description thereof);

W.R.T. Claim 10: Kara further discloses the system, wherein the client subsystem includes a GUI for entering a password to store the entered password and verify the password in the server subsystem (see Supra registration and installation);

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W.R.T. Claim 11: Kara further discloses the system, wherein the server subsystem includes an address matching module for verifying an address entered by the user (see Fig. 10);

W.R.T. Claim 12: Kara further discloses the system, wherein the GUI for installing software includes a GUI for the user to specify the type of connection to the computer network (see col. 9, lines 8-10);

W.R.T. Claim 13: Kara further discloses the system, wherein the GUI for installing software includes a GUI for reporting error messages to the user (see Figs. depicting "warning messages");

W.R.T. Claim 14: Kara further discloses the system, wherein the GUI for installing includes a GUI for canceling an installation process (see Fig. 2 for installation process. Inherently, the user can cancel the installation by not following the process, e.g. entering wrong information, not inserting a pertinent disk or not connecting the pertinent device);

W.R.T. Claim 15: Kara further discloses the system, wherein the GUI for registering the user includes a GUI for entering user information (see Supra installation and registration);

W.R.T. Claim 16: Kara further discloses the system, wherein the GUI for registering includes a GUI for offering the user a plurality of service plan and for selecting by the user a service plan for choice (e.g. see Fig. 8 for the service plan or choice that the user can select);

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W.R.T. Claim 17: Kara further discloses the system, wherein the GUI for registering includes a GUI for reporting error messages to the user (see Fig. 7, for the messages);

W.R.T. Claim 18: Kara further discloses the system, wherein the GUI for registering includes a GUI for canceling a registering process (see Supra the cancellation process for installation);

W.R.T. Claim 19: Kara further discloses the system, wherein the GUI for managing the printing includes a GUI for displaying a graphical image of the VBI (see Fig. 8);

W.R.T. Claim 23: Kara further discloses the system, wherein the GUI for managing includes a GUI for providing envelope options (see Figs. 8-9);

W.R.T. Claim 24: Kara further discloses the system, wherein the GUI for managing includes a GUI for providing label options (see Fig. 8);

W.R.T. Claim 25: Kara further discloses the system, wherein the GUI for managing includes a GUI for providing postage options (see Fig. 8);

W.R.T. Claim 27: further discloses the system, wherein the GUI for managing includes a GUI for canceling a print process (see Fig. 8 for the typical printing GUI that must include the cancel option (under the "File" or other Dropdown window option) for the print process); and

W.R.T. Claim 28: further discloses the system, wherein the GUI for specifying a payment method includes a GUI for displaying credit card information field to be filled by the user when the user specifies a credit card for the payment method (col. 11, lines 47-53).

W.R.T. Claim 29:

Kara discloses a system comprising:

an installation wizard including a GUI for downloading and installing software for postage printing from a server connected to a computer network (see Figs. 2-10 and the descriptions thereof);

a registration wizard including a GUI for facilitating the registration of a user using a user computer with the system (see *Id.*); and

a printing wizard including a GUI for facilitating printing of a postage indicium (see Fig. 8 specifically), wherein the server transmits an authorization message to the user for authoring the printing the VBI.

W.R.T. Claim 30: Kara further discloses the system, wherein the registration wizard includes a GUI for specifying a payment method (see col. 11, lines 25-53; Figs. 4A-B);

W.R.T. Claim 31: Kara further discloses the system, wherein the GUI for specifying a payment method includes a GUI for displaying credit card information field to be filled by the user (col. 11, lines 47-53);

W.R.T. Claim 33: Kara further discloses the system, wherein the registration wizard includes a GUI for displaying the user information, account information (see Fig. 3);

W.R.T. Claim 34: Kara further discloses the system, wherein the account information includes an amount of credit left in the account (see Figs. 4A-B, 8);

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W.R.T. Claim 35: Kara further discloses the system, wherein the installation wizard includes a GUI for specifying an address book from a plurality of address books to print the address (see Supra Claim 9);

W.R.T. Claim 36: Kara further discloses the system, wherein the registration wizard includes a GUI for entering a password to store the entered password and verify the password in the server subsystem (see Supra Claim 10);

W.R.T. Claim 37: Kara further discloses the system, wherein the server subsystem includes an address matching module for verifying an address entered by the user (see Supra Claim 11);

W.R.T. Claim 38: Kara further discloses the system, wherein the installation wizard includes a GUI for the user to specify the type of connection to the computer network (see Supra Claim 12);

W.R.T. Claim 39: Kara further discloses the system, wherein the installation wizard includes a GUI for reporting error messages to the user (see Supra Claim 13);

W.R.T. Claim 40: Kara further discloses the system, wherein the installation wizard includes a GUI for canceling an installation process (see Supra Claim 14);

W.R.T. Claim 41: Kara further discloses the system, wherein the registration wizard includes a GUI for entering user information (see Supra Claim 15);

W.R.T. Claim 42: Kara further discloses the system, wherein the registration wizard includes a GUI for offering the user a plurality of service plan and for selecting by the user a service plan for choice (see Supra Claim 16);

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W.R.T. Claim 43: Kara further discloses the system, wherein the registration wizard includes a GUI for reporting error messages to the user (see Supra Claim 17);

W.R.T. Claim 44: Kara further discloses the system, wherein the printing wizard includes a GUI for displaying a graphical image of a sample postage on an envelope (see Fig. 8);

W.R.T. Claim 48: further discloses the system, wherein the printing wizard includes a GUI for providing envelope options (see Supra Claim 23);

W.R.T. Claim 49: further discloses the system, wherein the printing wizard includes a GUI for providing label options (see Supra Claim 24); and

W.R.T. Claim 50: further discloses the system, wherein the printing wizard includes a GUI for providing postage options (see Supra Claim 25).

W.R.T. Claim 52:

Kara discloses a method for printing a VBI, comprising the steps of:

displaying a first GUI by the client system for registering a user (see Supra registration and installation);

establishing communication with the server via the computer network (see Figs. 1 and 10);

entering user information in the first GUI (see Supra installation and registration);

communicating the entered user information to the server (see Figs. 1, 2, 7, 10);

and

transmitting an authorization message from the server to the client system over the network for authoring the client system to print the VBI (see Id.).

W.R.T. Claim 53: Kara further discloses the method including:

displaying a second GUI by the client system having printing options for managing the printing of the VBI (see Fig. 8);

selecting one or more printing options from the second GUI; and

printing the VBI according to the selected option;

W.R.T. Claim 54: Kara further discloses the method, wherein the VBI bears postage value;

W.R.T. Claim 57: Kara further including displaying a third GUI for installing software for printing the VBI (see Figs. 1-2);

W.R.T. Claim 58: Kara further discloses method, wherein the step of displaying a first GUI includes a GUI for specifying a payment method (see Supra Claim 5);

W.R.T. Claim 60: Kara further displaying a GUI for displaying the user information, account information (see Fig. 3);

W.R.T. Claim 61: Kara further discloses the method, wherein the account information includes an amount of credit left in the account (see Supra Claim 8);

W.R.T. Claim 62: Kara further displaying a third GUI for specifying an address book from a plurality of address books to print the address (see Supra Claim 9);

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W.R.T. Claim 63: Kara further displaying a third GUI for entering a password to store the entered password and verify the password in the server subsystem (see Supra Claim 10);

W.R.T. Claim 64: Kara further verifying an address entered by the user (see Supra Claim 11);

W.R.T. Claim 65: Kara further displaying a GUI for offering the user a plurality of service plan and for selecting by the user a service plan for choice (see Supra Claim 16);

W.R.T. Claim 66: Kara further displaying a first GUI for reporting error messages to the user (see Supra Claim 13);

W.R.T. Claim 67: Kara further displaying a GUI for canceling a registering process (see Supra Claim 14);

W.R.T. Claim 68: Kara further displaying a second GUI for displaying a graphical image of the VBI (see Fig. 8);

W.R.T. Claim 72: Kara further displaying a second GUI for providing envelope options (see Supra Claim 23);

W.R.T. Claim 73: Kara further displaying a second GUI for providing label options (see Supra Claim 24);

W.R.T. Claim 74: Kara further displaying a second GUI for providing postage options (see Supra Claim 25);

W.R.T. Claim 76: Kara further displaying a second GUI for canceling a print process (see Supra Claim 27); and

W.R.T. Claim 77: Kara further displaying a second GUI for the user to withdraw the user's account (see Fig. 8 and the description thereof).

Claim Rejections - 35 USC § 103

7) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8) Claims 3-4, 6, 20-22, 26, 32, 45-47, 51, 55-56, 69-71, 75 and 78-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara.

Kara discloses the invention as cited above, but does not specifically disclose the subject matters of Claims 3-4, 6, 20-22, 26, 32, 45-47, 51, 55-56, 69-71, 75 and 78-79: wherein the VBI is a ticket; the VBI is one or more of a coupon, a voucher and a check; a GUI for making changes to the user's information; wherein the GUI for managing includes a first GUI for printing a quality assurance VBI; wherein the GUI for managing includes a second GUI for displaying selectable choices of a printed quality assurance VBI; wherein the GUI for managing includes a GUI for troubleshooting selected printing options; wherein the GUI for managing includes a GUI for reporting error messages to the user; wherein the registration wizard includes a GUI for making changes to the user's information; a third GUI for displaying selectable choices of the shape of printed sample VBI; a second GUI for communicating a message to the user; and the steps of: prompting the user to place an envelope in a printer;

displaying a plurality of patterns, wherein only one of the plurality of patterns completely prints onto the envelope fed through the printer;

selecting one of the plurality of displayed patterns based upon which pattern appears to the user; and

ascertaining if the printer feeds envelopes from the top, center, or bottom based on the selected pattern.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to: 1) make a ticket, one or more of a coupon, a voucher and a check; 2) make changes to the user's information; 3) include a first GUI for printing a quality assurance VBI; 4) include a second GUI for displaying selectable choices of a printed quality assurance VBI; 5) include a GUI for troubleshooting selected printing options; 6) include a GUI for reporting error messages to the user; 7) include a GUI for making changes to the user's information; 8) display selectable choices of the shape of printed sample VBI; 9) communicate a message to the user; and 10) include the steps of: "prompting the user to place an envelope in a printer; displaying a plurality of patterns, wherein only one of the plurality of patterns completely prints onto the envelope fed through the printer; selecting one of the plurality of displayed patterns based upon which pattern appears to the user; and ascertaining if the printer feeds envelopes from the top, center, or bottom based on the selected pattern" because Applicant has not disclosed that having the limitations of Claims 3-4, 6, 20-22, 26, 32, 45-47, 51, 55-56, 69-71, 75 and 78-79 provides an advantage, is used

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for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Kara because Kara discloses the system and method for registration, installation and printing the VBI, wherein the various GUI are utilized to execute the registration, installation and printing process, and it is well known in the art to include the other types of GUIs for executing the features as specified in Claims.

Therefore, it would have been an obvious matter of design choice to modify Kara to obtain the invention as specified in claims.

Conclusion

9) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,636,983 is cited to show a method and system for uniform resource locator status tracking to provide monitoring and tracking services for a plurality of devices.

WO01/50227 is cited to show a system and a method for managing generation of indicia representing payments for a plurality of users. The system includes a secure source of funds, an output station, at least one user workstation, each user workstation including user software for enabling the user to provide input data corresponding to indicia to be generated, a centralized software system for interacting with the user software.

WO 00/70503 is cited to show a configuration of the system having communications capabilities to download selected information objects, e.g., software components and data from a server.

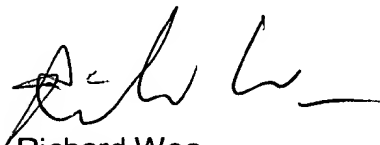
WO 00/19382 is cited to show a system for providing secured access to a software rental or a postage metering system. The virtual postage meter software enables a user to print postage indicia on documents, envelopes or labels.

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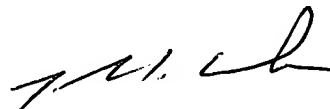
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
February 20, 2004



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